

REMARKS

Claims 1-5 and 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,334,861 to Chandler et al. (hereinafter “Chandler”) in view of U.S. Statutory Invention Registration No. H2037 H to Yates et al. (hereinafter “Yates”). Applicants submit that Chandler is disqualified as 35 U.S.C. § 102(e) prior art as applied in the 35 U.S.C. § 103 rejection because of common ownership or assignment, therefore, claims 1, 2, 6, 12 and 13, as amended herein, are allowable.

Under 35 U.S.C. § 102 “a person shall be entitled to a patent unless ... (e) the invention was described in...(2) a patent granted on an application for patent by another filed in the United States before the inventions by the applicant for patent.”

Chandler, issued *January 1, 2002*, and was a continuation of U.S. Application Serial No. 08/926,869 filed on *September 10, 1997* by Chandler et al. entitled “BIPOLAR INSTRUMENT FOR VESSEL SEALING”. The present application was filed on *December 12, 2003* and is a continuation of U.S. Application Serial No. 10/113,745 filed on April 1, 2002 by Buysse et al. entitled “BIPOLAR ELCTROCSURGICAL INSTRUMENT FOR SEALING VESSELS” which is a continuation-in-part of U.S. Application Serial No. 10/090,081 filed on March 1, 2002 by Buysse et al. entitled “BIPOLAR ELCTROCSURGICAL INSTRUMENT FOR SEALING VESSELS” which is a continuation of U.S. Application Serial No. 09/502,933 filed on February 11, 2000 by Buysse et al. entitled “BIPOLAR ELCTROCSURGICAL INSTRUMENT FOR SEALING VESSELS” which is a continuation of U.S. Application Serial No. 08/968,779 filed on *November 12, 1997* by Buysse et al. entitled “BIPOLAR ELCTROCSURGICAL INSTRUMENT FOR SEALING VESSELS”. Under a 35 U.S.C. § 102 rejection, Chandler could properly be cited as prior art, however, the claims are rejected under 35 U.S.C. § 103.

Under 35 U.S.C. § 103(c) “subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person” on all continuing applications filed on or after November 29, 1999.

At the time the invention of the present application was made both the present invention and the subject matter of the cited reference were commonly owned by, or subject to assignment to, Sherwood Services AG. “The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. § 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. § 103 in the parent application.” MPEP § 706.02(I)(1).

The present application was filed on *April 1, 2002* as a continuation of a continuation-in-part of a continuation of a continuation of an application filed *November 12, 1997*. Furthermore, Chandler could have been applied as 35 U.S.C. § 102(e) prior art in a rejection under 35 U.S.C. § 103 in the parent application.

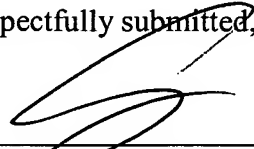
Claims 1, 2, 6, 12 and 13, as amended herein, are fully disclosed and supported by U.S. Application Serial No. 08/968,779 filed on November 12, 1997 by Buysse et al. entitled “BIPOLAR ELCTROCSURGICAL INSTRUMENT FOR SEALING VESSELS”. Therefore, the citation of Chandler as a disqualifying 35 U.S.C. § 102(e) prior art reference under 35 U.S.C. § 103, as relates to claims 1, 2, 6, 12 and 13, should respectfully be withdrawn. Since claims 4-5 depend from claim 2, claims 7-11 depend from claim 6, and claim 14 depends from claim 13,

and each contain all of the features of claims 2, 6 and 13, respectively, for the reasons presented above, it is respectfully submitted that claims 4-5, 7-11 and 14 are also patentable.

Claim 3 has been canceled in view of the amendment to claim 2, and claim 15 has been added.

In light of these amendments and remarks, favorable consideration and allowance of all outstanding claims are earnestly solicited. Should there be any questions after the Examiner's review of this paper; the Examiner is invited to contact the undersigned at (631) 501-5708.

Respectfully submitted,



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